



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,467	08/11/2000	CLinton L. Ballard	BA1.P25	7878

21450 7590 03/22/2004

STEVEN P KODA, KODA LAW OFFICE
8070 E MILLPLAIN BLVD, No.141
VANCOUVER, WA 98664

EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,467

Applicant(s)

BALLARD, CLINTON L.

Examiner

Zachary A Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-23 and 25-30 of the present application are currently under examination.

Drawings

2. The drawings are objected to because there are two figures labeled as Figure 2. It appears that the figures referred to as Figures 3 and 4 in the specification are mislabeled in the drawings as Figures 2 and 3, respectively. Further, these figures are objected to because they are hand-drawn figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

The specification appears to contain minor typographical errors. Specifically, on page 6, line 33, it is assumed that "os" is intended to read "is", and on page 8, line 12, "send" is intended to read "sent". Additionally, on page 7, line 27, a left parenthesis appears with no matching right parenthesis. Applicant's cooperation is requested in correcting any other errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Specifically, there is no Claim 24.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12, 14-21, 23, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marvit et al, US Patent 6625734, in view of Benson, US Patent 6301660.

In reference to Claim 1, Marvit discloses a method (see Figure 1) including defining a plurality of parameters for a secure message (column 4, lines 41-43, and

Art Unit: 2137

column 5, lines 2-7), sending the message from a sender and receiving the message at a receiver (column 5, lines 46-47), sending a request for a decryption key to a management module (column 5, lines 60-63), processing the request to determine whether the receiver is allowed to decrypt the message (column 10, lines 26-33), sending a denial message when the receiver is not permitted to decrypt (column 7, lines 52-54), sending the key to the receiver when permitted to decrypt (column 5, line 67-column 6, line 2), decrypting the message at the receiver (column 6, lines 3-4), and deleting the key (column 6, lines 4-6). Marvit further discloses that "a mechanism is provided that allows users to view cleartext, but does not provide the cleartext in any form that can be distributed to other users" (column 6, lines 18-20); however, Marvit does not specifically disclose reformatting the decrypted source format message into a prescribed format after decryption or deleting the source format message.

Benson discloses that a document translator translates the contents of an unprotected format document into a protected format document (column 10, lines 46-49; see also column 9, lines 23-63) and that the unprotected format document is part of a temporary file (column 10, lines 65-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Marvit by including the steps of reformatting the decrypted source format message into a prescribed format and deleting the source format message, in order to prevent viewing of the message by anyone other than an authorized user (see Benson, column 2, lines 23-26, and column 1, lines 7-9 and 21-37).

In reference to Claim 2, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses deriving a key having a sender-specified length at the management module (column 4, lines 41-43; also column 5, lines 42-44 where DES is the method of encryption used, where DES has a defined key length), defining a message code parameter (column 4, lines 41-43), and that sending the request includes sending the message code to the management module (column 5, lines 66-67).

In reference to Claim 3, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses sending a key parameter to the management module and storing the decryption key at the management module (column 4, lines 55-57), defining a message code parameter (column 4, lines 41-43), and that sending the request includes sending the message code to the management module (column 5, lines 66-67).

In reference to Claim 4, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses defining a message identification code (column 4, lines 41-43), defining an access parameter (column 10, lines 5-7), that the step of sending a request includes sending the message code from the receiver to the management module (column 5, lines 66-67), and that the step of processing the request includes testing the parameter to determine if the receiver is permitted to decrypt the message (column 10, lines 26-33).

In reference to Claim 5, Marvit and Benson disclose everything as applied to Claim 4 above, and Marvit further discloses that the access parameter is defined by the sender (column 9, lines 30-33).

In reference to Claim 6, Marvit and Benson disclose everything as applied to Claim 4 above, and Marvit further discloses that the message code is received at the management module (column 4, lines 55-57).

In reference to Claim 7, Marvit and Benson disclose everything as applied to Claim 4 above, and Marvit further discloses that the access parameter is a value known to the management module (column 10, lines 10-17, and column 11, lines 56-63).

In reference to Claim 8, Marvit and Benson disclose everything as applied to Claim 4 above, and Marvit further discloses that the message code is defined by the management module and transmitted to the sender (column 4, lines 41-43, and column 5, lines 37-38).

In reference to Claim 9, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses maintaining a count of the number of times the decryption key has been sent to a receiver (column 7, lines 62-66) and testing to determine whether the count exceeds a maximum number of times (see column 9, line 67-column 10, line 3 and column 11, lines 8-11).

In reference to Claim 10, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses testing to determine if a permissible time has expired (column 10, lines 57-59).

In reference to Claim 11, Marvit and Benson disclose everything as applied to Claim 1 above, and Marvit further discloses monitoring and testing a contingent event (see column 9, lines 33-35, and column 9, line 67-column 10, line 3).

In reference to Claim 12, Marvit and Benson disclose everything as applied to Claim 1 above, and Benson further discloses that the file may be in a graphic image format (column 9, lines 7-10).

In reference to Claim 14, Marvit discloses a method (see Figure 1) including setting a send configuration parameter for a secure message (column 10, lines 9-12), routing the parameter to a management module (column 10, lines 12-14), sending the message from a sender and receiving the message at a receiver (column 5, lines 46-47), sending a request for a decryption key to the management module (column 5, lines 60-63), processing the request to determine whether the receiver is allowed to decrypt the message (column 10, lines 26-33), sending a denial message when the receiver is not permitted to decrypt (column 7, lines 52-54), sending the key to the receiver when permitted to decrypt (column 5, line 67-column 6, line 2), decrypting the message at the receiver (column 6, lines 3-4), and deleting the key (column 6, lines 4-6). Marvit further discloses that "a mechanism is provided that allows users to view cleartext, but does not provide the cleartext in any form that can be distributed to other users" (column 6, lines 18-20); however, Marvit does not specifically disclose reformatting the decrypted source format message into a prescribed format after decryption or deleting the source format message.

Benson discloses that a document translator translates the contents of an unprotected format document into a protected format document (column 10, lines 46-49; see also column 9, lines 23-63) and that the unprotected format document is part of a temporary file (column 10, lines 65-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Marvit by including the steps of reformatting the decrypted source format message into a prescribed format and deleting the source format message, in order to prevent viewing of the message by anyone other than an authorized user (see Benson, column 2, lines 23-26, and column 1, lines 7-9 and 21-37).

Claim 15 is a system claim corresponding substantially to the method of Claim 1, and is rejected by a similar rationale.

Similarly, system Claim 16 corresponds substantially to method Claim 9; Claims 17 and 18 to Claim 10; Claim 19 to Claim 11; Claim 21 to Claim 12; Claim 25 to Claim 6; Claim 26 to Claim 3; Claim 27 to Claim 5; Claim 28 to Claim 8; Claim 29 to Claim 2; and Claim 30 to Claim 7. The system claims are rejected by a similar rationale as the method claims.

In reference to Claim 20, Marvit and Benson disclose everything as applied to Claim 15 above, and Marvit further discloses that the management module may reside

with the sender (column 16, lines 35-56, where the keys are stored offline on the user's computer).

In reference to Claim 23, Marvit and Benson disclose everything as applied to Claim 15 above, and Marvit further discloses that the management module resides at a server computer (see Figure 1, key repository 106; also column 20, lines 19-21).

7. Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marvit in view of Benson as applied to claim 1 above, and further in view of Mack et al, US Patent 5673385.

In reference to Claim 13, Marvit and Benson disclose everything as applied to Claim 1 above; however, Marvit and Benson do not disclose disabling interrupts at the receiver during the steps of decrypting, reformatting, and deleting.

Mack discloses disabling interrupts (column 3, lines 47-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Marvit and Benson by including the step of disabling interrupts, in order to reduce the risk of system-wide failure by limiting the number of resources initialized (see Mack, column 3, lines 51-55).

Claim 22 is a system claim corresponding substantially to the method of Claim 13, and is rejected by a similar rationale.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ganesan, US Patent 557678, discloses a system including a central authority for session key distribution.
- b. Dolan et al, US Patent 6504801, disclose a system including a central server storing private keys in encrypted form.
- c. Schwab, US Patent 5973731, discloses a system in which image files are reformatted for security purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is 703-305-8902. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~~ZAD~~
zad

Matthew Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137